

Appln. No. 10/813,423

Attorney Docket No. 8627-452
Client Reference No. PA-5344-RFB/DIV

II. Remarks

Claims 1-5 are rejected and pending. With the remarks provided herewith, the Applicants respectfully request reconsideration and a withdrawal of all the rejections to the claims.

Claim Rejections - 35 U.S.C. §102(b)

Responsive to the rejections of claims 1, 2, 4 and 5 under 35 U.S.C. §102(b) as being anticipated by European Patent No. 0,769,306 to Engelson (*Engelson*), *Engelson* does not teach each and every element of the claimed invention. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. For example, each of claims 1 and 5 recite the steps of applying a first coating over a mandrel having a proximal portion and a distal portion and removing the first coating from the distal portion of the mandrel. Contrarily, *Engelson* teaches the application of a first coating solely over the proximal region of a mandrel rather than over the mandrel having a proximal portion and a distal portion.

Further, the Examiner's assertion that *Engelson* teaches the step of removing the first coating from the distal portion of the mandrel is misplaced. Since *Engelson* fails to disclose the application of a first coating to the distal portion of the mandrel, *Engelson* cannot possibly disclose the removal of such coating from the distal portion of the mandrel as recited in claims 1 and 5. The procedure to remove the first coating from the distal portion of the mandrel the Examiner refers to is merely a cleaning process to prepare the guidewire for the application of a hydrophilic polymer rather than a process for removing a first coating from the distal portion of the mandrel. (*Engelson*, col.10, lines 10-15). *Engelson* discloses that the guidewire

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core is "cleaned with an oxygen plasma etch," and a "plasma-polymerized tie layer" is deposited "on the guidewire core to complete the pretreatment." (Col. 10, lines 16-20). *Engelson* further discloses that "the pretreated guidewire may then be coated by a hydrophilic polymer." (Col. 10, lines 48-49). However, *Engelson* does not disclose the steps of applying a first coating to a mandrel and *removing* the first coating from the distal portion of the mandrel. Hence, *Engelson* fails to teach each and every element of the claimed invention.

Accordingly, reconsideration of the rejections under 35 U.S.C. §102(b) and the allowance of claims 1 and 5 are respectfully requested. Further since claims 2 and 4 depend generally from claim 1, the reasons for allowance of claim 1 apply as well to the dependent claims.

Claim Rejections - 35 U.S.C. §103(a)

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over *Engelson* in view of U.S. Patent No. 6,652,472 to Jafari et al. (*Jafari*). Since claim 3 generally depends from claim 1, the reasons for allowance of claim 1 apply as well to claim 3. Accordingly, reconsideration and a withdrawal of the rejections under 35 U.S.C. §103(a) are respectfully requested.

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Conclusion

Claims 1-5 are in a condition for allowance and such action is earnestly solicited.

Respectfully submitted,

February 19, 2007
Date



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